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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,905	03/05/2002	Robert L. Campbell	41551	7713
1609	7590	04/20/2004	EXAMINER	
ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.				MARSCHEL, ARDIN H
1300 19TH STREET, N.W.				
SUITE 600				
WASHINGTON,, DC 20036				
				ART UNIT
				PAPER NUMBER
				1631

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/087,905	CAMPBELL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ardin Marschel	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 January 2004.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 16,17,31-40,55,56,59-73 and 113-126 is/are pending in the application.

4a) Of the above claim(s) 16,17,31-40,55,56,59-73 and 113-118 is/are withdrawn from consideration.

5) Claim(s) 1-15,18-30,41-54,57,58,74-112, & 127 have been canceled. ~~REMOVED~~

6) Claim(s) 119-126 is/are rejected.

7) Claim(s) 120-122 and 124-126 is/are objected to.

8) Claim(s) 16,17,31-40,55,56,59-73 and 113-126 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
~~REMOVED~~ Paper No./Mail Date (2 sheets)

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_ .

### **DETAILED ACTION**

Applicants' election without traverse of Group IX [specie  $y_i = f(x_{ij})$  function as setting forth all the variables] in the Paper filed 1/22/04 is acknowledged. Therefore, instant claims 119-126 are under examination.

### **SEQUENCE RULE NON-COMPLIANCE**

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR §§ 1.821(a)(1) and (a)(2). See, for example, the sequences in the specification on page 45, line 12. However, this application fails to comply with the requirements of 37 CFR §§ 1.821 through 1.825 because it lacks a SEQ ID NO: cited along with each sequence in the specification on page 45. Applicants are also reminded that SEQ ID Nos are not required in Figures per se, however, the corresponding SEQ ID Nos then are required in the Brief Description of the Drawings section in the specification. Applicants are also reminded that a CD-ROM sequence listing submission may replace the paper and computer readable form sequence listing copies. Applicant(s) are given the same response time regarding this failure to comply as that set forth to respond to this office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

### **NON-STATUTORY SUBJECT MATTER**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 119-126 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Consideration of the “Computer-Related Inventions” section of the MPEP at section 2106, Part IV, subpart B, has revealed that the instant claims are directed to non-statutory subject matter without requiring performance of a result outside of a computer. Thus, the manipulation of data or conversion of data, in this case determining a relationship from a first test library and then identifying a second test library is the claimed subject matter without any physical transformation outside of a computer. It is noted that instant claim 119 cites an apparatus but is reasonably deemed a computer as its general embodiment which performs determination and identification without any requirements for physical action or movement cited in the claims. It is also noted that claims 123-126 cite a computer program product which is “tangibly embodying a program...” but without citing any tangible physical transformation in the actual steps of the program. It is noted that nonfunctional material which lacks statutory subject matter is not made statutory by merely being carried in a computer apparatus or computer program product.

#### **VAGUENESS AND INDEFINITENESS**

Claims 119-126 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 120 the “ $\hat{y}_i$ ” values is cited as an estimate of “measured first indicia”. In claim 119 a relationship is determined in lines 3-6 but without connection or definition of

cooperativity between measured first indicia in order to define either the “relationship” in claim 119 nor the connection of such a “relationship” to the “ $\hat{y}_i$ ” values. Thus, the metes and bounds of the determining of said “relationship” via the “ $\hat{y}_i$ ” values is undefined as claimed and therefore vague and indefinite as to what is meant. Clarification via clearer claim wording is requested. This vagueness and indefiniteness also is present in claims 123 as compared to claim 124 as well as in claims dependent from any of these claims via their dependence.

Similarly, the connection(s) between the distance determination of claims 122 or 126 to the relationship or the “ $\hat{y}_i$ ” values is undefined and thus also vague and indefinite. Clarification via clearer claim wording is requested.

Additionally, means plus function claim wording is cited in the instant claims, such as in claim 119, lines 3-10, however, consideration of the entirety of the instant disclosure as filed has failed to reveal a statement which clarifies the metes and bounds of any of the means cited in the instant claims. Clarification via clearer claim wording is requested.

## **INFORMALITIES**

The disclosure is objected to because of the following informalities:

The parameters wherein subscripts are present are printed with too small of a font to read them clearly. Claims 120-122 and 124-126 are hereby required to be submitted with larger font for readability.

Appropriate correction is required.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

April 16, 2004

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER  
4/16/04